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39313 7590 03/04/2009 CARL M. NAPOLITANO, PH.D. ALLEN, DYER, DOPPELT, MILBRATH & GILCHRIST, P.A. 255 SOUTH ORANGE AVE., SUITE 1401 P.O. BOX 3791 ORLANDO, FL 32802-3791				
EXAMINER				
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/721,962
Filing Date: November 25, 2003
Appellant(s): HERRIN, ROBERT M.

Carl Napolitano
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/19/08 appealing from the Office action mailed 11/8/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is not correct. As noted in the Advisory Action of 12/5/07 the amendment to the claims of 11/19/07 was not entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: Section B should read whether claims 7,9, and 53-54 are unpatentable under 35 USC 103(a) over Royal in view of Applicant's Admitted Prior Art.

(7) Claims Appendix

A substantially correct copy of appealed claim 6 appears on page 39 in the Appendix to the appellant's brief. The minor errors are as follows: "preselected" should be inserted between –a—and –fixed—in line 1.

(8) Evidence Relied Upon

3,978,774

Royal

9-1976

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

Claims 6-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is confusing and indefinite as to how the platen operable for moving between a first position and second positions (claim 1) comprises a "preselected" fixed peripheral portion". (claim 6, line 2).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8, 10-19, 48-52 and 55-56 are rejected under 35 U.S.C. 102(b) as being anticipated by Royal (US-3,978,774).

Royal discloses an apparatus comprising a platen 48 with guide plate for driving/biasing the blank downstream via drive mechanism 49; forming rails 70, a first folding arm 80 positioned proximate the distal portion of forming rail 70; compression plate 54 and fixed plate 74 (parallel to the path of the platen 48) that forms a passage therebetween; second folding arm 80/82 for biasing against the portion of the formed tray through the passage; in-feed conveyor 118; adhesive applicators 122 positioned upstream platen 48; opposing end rails 65; opposing edge rails 79; opposing side folding rails 132; locking arm 88 secures the tray in the second position via drive device 86; see figures 4-8.

Regarding claim 14, there is a magazine styled frame downstream the second position; see figure 9.

Regarding claims 15-16 and 18-19, the examiner notes that expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. See *ex parte* Thibault, 164 USPQ 666, 667 (Bd App. 1969). Furthermore, inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims. In *re* Young, 75 F.2d 996, 25 USPQ 69 (CCPA 1935) (as restated in *re* Otto, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963). Royal presents a box blank with a multitude of fold/score lines which the folding elements fold as claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 9, and 53-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Royal (US-3,978,774) in view of AAPA.

Royal does not show beveled edges as claimed or a surface with depressions as claimed. The examiner already took official notice that it is well known in the art to use beveled edges or to have a surface with depressions for reducing the frictional contacting surface in a previous office action and since applicant did not traverse the official notice assertion, this is admitted as prior art in accordance with MPEP 2144.03(c).

Claims 57-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Royal (US-3,978,774) in view of Official Notice/Admitted Prior Art.

The invention to Royal fails to disclose folding arms capable of rotation about first and second axes of rotation (perpendicularly arranged), however the examiner takes OFFICIAL NOTICE that there are well known mechanical joints (ie. a universal joint) for enabling rotational movement of elements along at least two axes. It would have been obvious to one of ordinary skill in the art to provide such a mechanical connection in the invention to Royal for rotating the folding arms out of the folding passage along a

second axis (perpendicular to the first) in order to prevent interference with the advancement of the next product.

The common knowledge modification in the above paragraph is taken to be admitted prior art because applicant failed to traverse the examiner's previous assertion of Official Notice.

(10) Response to Argument

Appellant's claims are not distinguishable over the prior art. During patent examination, the pending claims must be interpreted as broadly as their terms reasonably allow. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 320,322 (Fed. Cir. 1999). In determining the patentability of claims, the PTO gives claim language its broadest reasonable interpretation" consistent with the specification and claims. *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See MPEP § 904.1. Royal discloses the claimed invention. Appellant points out differences in the operation of the device to Royal, however these differences are not claimed. The claimed limitations are directed towards a passage formed between a fixed plate and compression plate with a second folding arm movable through the passage. Royal discloses compression plate 54 (figure 6) is aligned as claimed and moved in a downward direction past fixed plate 74 (figure 7). These elements are considered to form a passage (vertical plane defined by the special relationship and movement of compression plate 54) between in which a portion of a box blank is carried. Folding arms 80/82 are capable of moving through (ie. into and out of) this passage in a rotatable manner. The claims do not simply define the elements with sufficient structural relationship to one another, as discussed at length in

the Interview of 12/13/07. There is no misunderstanding of the claimed invention.

There is no modification of Royal in the application of the rejection under 35 USC 102(b). The appellant's claims are read in a reasonably broad manner as required by the MPEP (see above) and are considered to anticipate each and every limitation of the claims.

Note further that limitations such as "movable"; "operable"; "movably positioned"; "rotatable" recited throughout the claims (see claims 1, 8, 11, 48, etc.) only require capability of the relative elements to perform the relative functions. While features of an apparatus may be recited either structurally or functionally, claims directed towards an apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Schreiber*, 128 F.3d 1473-78, 44 USPQ2d 1429-32 (Fed.Cir. 1997) and *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed.Cir. 1990). Furthermore, a limitation directed to an intended use of an apparatus or a process requires a structural difference or a manipulative difference between the claimed invention and the prior art. See *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963); *In re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962); *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). Certain claimed elements (e.g. platen, second folding arm, locking arm) merely have to be capable of performing a function as claimed. No explicit disclosure of the recited function from Royal is necessary for anticipation under 35 USC 102(b).

Regarding dependent claims 2-6, 10-19, 49-50, 52, and 55-56, appellant again fails to distinguish over the prior art with sufficient descriptive limitations; see above. The mandrel 48 of Royal has multiple surfaces that are fixed into multiple positions for forming a folded blank and further comprises elements which also have fixed peripheral portions e.g. plate 46. Locking arm 88 performs a locking operation which is considered "operable with the folding rail" as claimed. Royal is considered to teach a "magazine styled frame". Regarding claim 49, Official Notice is not relied upon as the claimed elements are anticipated.

Regarding the common knowledge modification previously taken (Official Notice), in order to adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See MPEP 2144.03(c) and also Chevenard, 139 F.2d at 713, 60 USPQ at 241. Appellant failed to do so. The finding of Admitted Prior Art is in accordance with MPEP 2144.03.

Regarding the rejection of claims 57-58, Official Notice was taken in the previous action (Final Rejection of 11/8/07). As required by the MPEP (as noted supra) traversal of the common knowledge modification must be argued in the next response. Appellant's arguments fail to adequately traverse the modification as required as they do not include stating why the noticed fact is not considered common knowledge. Note claim 57 calls for rotational capability of first and second folding arms about first and second perpendicular axes of rotation. The examiner took Official Notice that

mechanical joints are well known in the art for providing rotational movement about perpendicular axes (ie. universal joint). One of ordinary skill in the art would have recognized the inclusion of such a mechanical device for providing the rotational capability as claimed for moving the folding arms as desired (for instance for maintenance or when a blank is jammed/stuck in place). Appellant has not challenged that such joints are not known or somehow could not be included in the device. Accordingly the lack of proper traversal requires that this modification is now Admitted Prior Art; see MPEP 2144.03.

Note that a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill. While evaluating obviousness, one must ask whether the improvement is more than the predictable use of prior-art elements according to their established functions; see *KSR Int. v. Teleflex 550 US__* (2007).

To determine whether there was an apparent reason to combine the known elements in the way a patent claims, it will often be necessary to look to interrelated teachings of multiple patents; to the effects of demands known to the design community or present in the marketplace; and to the background knowledge possessed by a person having ordinary skill in the art; *ibid*.

The analysis need not seek out precise teachings directed to the challenged claimed specific subject matter, for a court can consider the inferences and creative steps a person of ordinary skill in the art would employ. Under the correct analysis, any

Art Unit: 3721

need or problem known in the field and addressed by the patent can provide a reason for combining the elements in the manner claimed; *ibid*.

One of ordinary skill in the art could have easily modified Royal in a predictable manner in order to arrive at the claimed invention.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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TQAS TC 3700